

Appl. No. 10/603,546
Examiner: RIELLEY, ELIZABETH A, Art Unit 2879
In response to the Office Action dated June 15, 2006

Date: September 14, 2006
Attorney Docket No. 10112271

REMARKS

Responsive to the Office Action mailed on June 15, 2006 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

Present Status of Application

Claims 1, 2, 5-9 and 14-29 are pending in the application. Claims 1, 2, 5-9, 14-20, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Namikawa et al (US 5,600,2003, hereinafter "Namikawa"). Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa in view of Yakou et al (US 5,855,637, hereinafter "Yakou"). Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa in view of Guenther et al (US 6,949,880, hereinafter "Guenther").

In this paper, claims 1 and 25 are amended. Support for the amendments can be found at least on pages 7-8 of the application.

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

Rejections Under 35 U.S.C. 102(b)

Claims 1, 2, 5-9, 14-20, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Namikawa. To the extent that the grounds of the rejections may be applied to the claims now pending in this application, they are respectfully traversed.

To anticipate a claim, a reference must teach every element of the claim. In this regard, the Federal Circuit has held:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros.*

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v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As amended, claim 1 recites a method of repositioning display spacers using inductive attraction comprising the steps of providing magnetic spacers; providing an inductive chuck to attract the spacers by magnetic force, wherein a voltage is applied to the inductive chuck and the spacers are lifted by the inductive chuck; providing a substrate; aligning the spacers with desired positions on the substrate; and interrupting the voltage applied to the inductive chuck.

In the rejections, the Examiner identifies Ni element 113 as the alleged magnetic spacers of claim 1 and magnetic elements 114 on glass substrate 7 as the alleged inductive chuck of claim 1. See page 2 of the office action.

Namikawa teaches a method of making an image display panel in which a Ni element 113 is formed on one end of each of sliced glass fiber bundle pieces 6. A jig having magnetic elements 114 incorporated therein at predetermined pitches is arranged on a glass substrate 7. The glass substrate 7 is put on the glass fiber bundle pieces 6 while turning the magnetic elements 114 down, resulting in the glass fiber bundle pieces 6 being aligned at one end thereof with the magnetic elements 114. The glass fiber bundle pieces 6 are then each contacted at the other end thereof with ultraviolet-curing adhesive 111 which contains an inorganic material and is previously deposited with a thickness of several microns on a glass substrate 112, so that the adhesive 111 is adhered to the other end of each of the glass fiber bundle pieces 6. The glass fiber bundle pieces 6 are subjected to ultraviolet-light irradiation to cure the adhesive, followed by removal of the glass substrate 7. See col. 10, line 45 to col. 11, line 20 of Namikawa.

In Namikawa, the glass substrate 7/magnetic elements 114 are not attracted to the Ni element 113 tips by applying a voltage to the glass substrate 7/magnetic elements 114 to generate

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magnetic force. Applicant therefore submits that Namikawa fails to teach or suggest the limitation wherein "a voltage is applied to the inductive chuck and the spacers are lifted by the inductive chuck." Furthermore, Namikawa fails to teach or suggest a step of interrupting a voltage applied to glass substrate 7/magnetic elements 114, as recited in the claim.

For at least the reasons described above, it is Applicant's belief that Namikawa fails to teach or suggest all the limitations of claim 1. Applicant therefore respectfully requests that the rejection of claim 1 be withdrawn and the claim passed to issue. Insofar as claims 2, 5-9, 14-24 depend from claim 1 either directly or indirectly, and therefore incorporate all of the limitations of claim 1, it is Applicant's belief that these claims are also in condition for allowance.

Rejections Under 35 U.S.C. 103(a)

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa in view of Yakou. As noted above, it is Applicant's belief that claims 21 and 22 are allowable by virtue of their dependency from claim 1. For this reason, the Examiner's arguments in connection with these claims are considered moot and will not be addressed here.

Claims 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Namikawa in view of Guenther. To the extent that the grounds of the rejections may be applied to the claims now pending in this application, they are respectfully traversed.

MPEP 2142 reads in part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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In connection with the third criteria, MPEP 2143.03 goes on the state:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 25 recites a method of repositioning display spacers using inductive attraction, comprising the steps of providing spacers made of electrostatic materials; providing an inductive chuck to attract the spacers by electrostatic force, wherein a voltage is applied to the inductive chuck and the spacers are lifted by the inductive chuck; providing a substrate; aligning the spacers with desired positions on the substrate; and interrupting the voltage applied to the inductive chuck.

The Examiner relies on Namikawa to teach all the limitations of the present invention except for the "electrostatic" spacers and "electrostatic force." Guenther is relied upon to teach the use of electrostatic force "to move spacers."

Applicant first respectfully disagrees with the Examiner's application of Guenther in the rejections. Contrary to the present invention, in which a spacer is aligned in a desired position with a chuck, Guenther teaches a technique of distributing spacers on a substrate by dry spaying. As described in col. 4, lines 11-25 of Guenther:

Dry spray techniques typically comprise electrostatically charging the spacer particles with a first polarity (positive or negative) and the substrate with a second polarity (negative or positive). The spacer particles are blown against the substrate with dry air supplied by a dry air sprayer ...

... Electrostatic attraction causes the spacer particles to adhere to the substrate while electrostatic repulsion between the particles prevents particle agglomeration on the substrate. A particle density of 160-180 No/mm.sup.2 can be achieved using a dry air

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sprayer which generates dry air, for example, having a dew point .ltoreq.-58.degree. C. at pressure of 2 kg/cm.sup.2 and a current of 50 l/min for 10 s spray duration. By varying the spraying parameters, other particle densities can be achieved.

Thus, in Guenther, electrostatic force is not used "to move spacers" in the manner recited in claim 25, but rather the electrostatic properties of attraction and repulsion are relied upon in spraying to achieve certain particle densities on a substrate. The teaching of electrostatic properties in Guenther does address the recited limitations of claim 25, namely "providing an inductive chuck to attract the spacers by electrostatic force, wherein a voltage is applied to the inductive chuck and the spacers are lifted by the inductive chuck."

Furthermore, in none of Namikawa, Guenther, or the combination thereof, is there any teaching or suggestion of a voltage applied to the inductive chuck or a lifting of the spacers by the inductive chuck, as recited in claim 25. In addition, the references fail to teach or suggest a step of interrupting the voltage applied to the inductive chuck, as recited in the claim.

It is therefore Applicant's belief that even when taken in combination, the prior art references relied upon by the Examiner do not teach or suggest all the limitations of claim 25. For at least this reason, a *prima facie* case of obviousness cannot be established in connection with this claim. Furthermore, as it is Applicant's belief that a *prima facie* case of obviousness is not established for claim 25, the Examiner's arguments in regard to the dependent claims are considered moot and are not addressed here. Allowance of claims 25-29 is respectfully requested.


Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Nelson A. Quintero', written over a horizontal line.

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